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No. 5,875,403 issued to Christal (hereinafter "Christal"). Applicants respectfully disagree for the following reasons.

In order to establish a *prima facie* of obviousness, the Examiner must show that these cited references combined teach or suggest each element of the claim. In regard to claims 35, 44 and 47, these claims includes the element of "in response to a user input initiating a transmission mode, automatically selecting a form for a message to be transmitted based on a content of a displayed information at the time that user input is received." Claim 35, lines 7-9. Neither Nguyen nor Christal teach this element of claims 35, 44 and 47. Nguyen teaches a device capable of receiving short message service (SMS) messages which includes a text editor to edit messages to be sent in the SMS format. See Nguyen, col. 6, lines 17-34. Nguyen did not teach the use of a form in connection with messaging and thus does not teach or suggest selecting a form based on content of information being displayed from received data. Christal does not cure the defects of Nguyen. Christal teaches a device that provides two options for responding to SMS messages. The first option for responding to SMS messages taught by Christal is sending back a pre-set 'Yes' message when viewing a message by pressing sequentially an option button, a 'Yes' button and finally a send button to send the message. See Christal, col. 2, lines 29-34, and Figure 4. A second option while viewing a received message is to press the option button and then to press an edit button which allows the creation of a return message using a key pad and then the message can be sent by pressing the send button. See Christal, col. 2, lines 34-47. Neither of these two manners of responding to a message taught by Christal involves an automatic selection of a form for a message to be transmitted based on the content of received information. All the content of the messages generated for reply taught by Christal are a result of direct user selection (i.e., selecting a 'Yes' message by a sequence of buttons or composing a message on a key pad).

Thus, Christal does not teach an *automated* selection of a form *based on the content* of displayed information. Therefore, the combined references do not teach each of elements of claims 35, 44 and 47. Accordingly, reconsideration and withdrawal of the obviousness rejection of claims 35, 44, and 47 are requested.

In regard to claims 36, 37, 43, 45, 46, 48 and 49, these claims depend from independent claims 35, 44 and 47 and incorporates the limitations thereof. Thus, at least for the reasons mentioned in regard to claims 35, 44 and 47, these claims are not obvious over the cited references. Accordingly, reconsideration and withdrawal of the obviousness rejection of claims 36, 37, 43, 45, 46, 48 and 49 are requested.

In regard to claims 38 and 53, these claims include the elements of "monitoring the content of the data for a predetermined content" as the data is received and "in response to detecting the predetermined content automatically entering a mode for allowing a user to transmit a message from the telephone." The Examiner admits, in Paper No. 9, that Nguyen does not specifically disclose the use of automatically entering a reply mode when a message is selected. Thus, Nguyen does not teach monitoring data being received and when detecting a predetermined content automatically entering a mode to allow a user to transmit a message. Nor does Christal cure this defect of Nguyen. The Examiner has not identified any part of Christal that teaches entering a mode to transmit a message upon detecting predetermined content in data being received from a remote source as claimed in claims 38 and 53. Further, the Examiner mischaracterizes Figure 4 of Christal as teaching the automatic entry to reply mode "if the user does not wish to create a return message with the keyboard, at the end of an incoming message." Page 6 of Paper No. 9. As discussed in regard to claim 35, Christal teaches two means for

replying to a received message both at least involve the action of a user to press an options button. See Figure 4, Figure 2 in col. 2, lines 29-32, and lines 38-41. Thus, Christal does not teach the automatic entry into a reply mode because user input is required. Nguyen combined with Christal does not teach entering a mode for transmitting a message automatically upon detecting a predetermined content in the received data. Therefore, Christal combined with Nguyen does not teach each element of claims 38 and 53. Accordingly, reconsideration and withdrawal of the obviousness rejection of claim 38 and 53 are requested.

In regard to claims 39-42, 54 and 55, these claims depend from independent claims 38 and 53 incorporate the limitations thereof. Thus, at least for the reasons mentioned in regard to claims 38 and 53, these claims are not obviousness over the cited references. Accordingly, reconsideration and withdrawal of the obviousness rejection of claims 39-42, 54 and 55 are requested.

In regard to claim 56, this claim includes the element of a control circuit configured to "detect predetermined content in the non-voice data" being received from a remote source, and a control circuit being configured to "enter transmission mode for allowing a user to transmit an electronic mail message in response to detecting the predetermined content." Thus, for the reasons mentioned in regard to claim 38 and 53, this claim is not obvious over Nguyen and Christal. In addition, this claim includes the element of automatically selecting a message to be transmitted in response to detecting the predetermined content. Claim 56, lines 8 and 9. Neither Christal nor Nguyen teach detecting predetermined content and data being received and thus do not teach selecting a message to be transmitted in response to the predetermined content automatically. Therefore, Christal combined with Nguyen, does not teach each of the elements of

claim 56. Accordingly, reconsideration and withdrawal of the obviousness rejection of claim 36 are requested.

Double Patenting

The Examiner rejects claims 35-49 and 53-56 under the judicially created doctrine of obviousness type double patenting as being unpatentable over claims 1-14 of U.S. Patent No. 6/169,911, issued to Wagner et al. (hereinafter "Wagner"). Applicants respectfully disagree for the following reasons.

To establish a *prima facie* case of non-statutory type double patenting, the Examiner must show that any variation between the inventions and the claims under consideration and the issued patent's claims would have been obvious to a person of ordinary skill in the art.

In regard to independent claims 35, 44, 47 and 56, Applicants note that the Examiner has not identified where in the claims of Wagner that the automatic selection of a form for a message to be transmitted based on the content of despite information is claimed. Rather, Wagner claims only automatically selecting and displaying a reply form in response to user input. See claim 11 of Wagner. Thus, claims 35, 44, 47 and 56 and dependent claims 36, 37, 43, 45, 46, 48 and 49 are patentably distinct from claims 1-14 of Wagner.

In regard to claims 38 and 53, the Examiner mischaracterizes the claims of Wagner as teaching "entering an automatic reply mode such as an e-mail reply mode or a voice reply mode based on a source identifier in the received message. However, the claims of Wagner in fact claim entering a reply mode based on user input. See claim 1, lines 16-20; claim 3, lines 11-13; claim 6, lines 22-25; claim 7, lines 19-22; claim 8, lines 10-15; claim 12, lines 12-17; and claim 14, lines

12-18. In each of these claims, Wagner teaches that once the reply mode has been entered based upon user input, that either an electronic mail mode or a voice reply mode is selected based on the source identifier. Thus, the source identifier chooses between mode, but does not initiate the entering of the mode as claimed in the claims 38 and 53, and thus, dependent claims 40-42, 54 and 55. Accordingly, reconsideration and withdrawal of the double patenting rejection of claims 35-49 and 53-56 are requested.


CONCLUSION

In view of the foregoing, it is believed that all claims now pending, namely claims 35-49 and 53-56, patentably define the subject invention over the prior art of record and are patentably distinct from Wagner, and are thus in condition for allowance and such action is earnestly solicited at the earliest possible date. If the Examiner believes that a telephone conference would be useful in moving the application forward to allowance, the Examiner is encouraged to contact the undersigned at (310) 207 3800.

Respectfully submitted,

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I hereby certify that this paper is being facsimile transmitted to the
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